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Name: Examiner DARROW, Justin T.
Loc: Group 2132 / USPTO
Fax No.: 703-872-9306
Phone No.:
Subject: US Appln. No. 09/398,665
Your File No.: 09/398,665

FROM

Name: Andrew B. Schwaab
Phone No.: 650-849-6643
Fax # Verified by: abs
Pages (incl. this): 58
Date: August 3, 2004
Our File No.: 07451.0005-01

Message:

In re Application of:

GINTER et al.

Application No.: 09/398,665

Filed: September 17, 1999

For: **DIGITAL CERTIFICATE SUPPORT
SYSTEM, METHODS AND TECHNIQUES
FOR SECURE ELECTRONIC COMMERCE
TRANSACTION AND RIGHTS
MANAGEMENT (as amended)**

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) Group Art Unit: 2132

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) Examiner: DARROW, Justin T.
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Examiner Darrow:

Submitted herewith is the Final Updated Notice of the related litigation, regarding which Microsoft has taken a comprehensive license to InterTrust's patent portfolio for a one-time payment of \$440 million.

Regarding the abandonment of the above-mentioned case, the Office (1) explained that our timely-filed Response has been located, and (2) indicated, via voicemail, that the above-referenced application would be withdrawing the abandonment; Applicants respectfully submit that such action be finalized, as might be confirmed by private PAIR.

Please call if you have any questions or would like additional information (650-849-6643).

Sincerely,
Andrew Schwaab

If there is a problem with this transmission, notify fax room at (650) 849-6600 or the sender above.

This facsimile is intended only for the individual to whom it is addressed and may contain information that is privileged, confidential, or exempt from disclosure under applicable law. If you have received this facsimile in error, please notify the sender immediately by telephone (collect), and return the original message by first-class mail to the above address.

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Appln. No.: 09/398,665
Final Updated Notice of Related Litigation,
filed August 3, 2004

PATENT
Customer No. 22,852
Attorney Docket No. 7451.0005-01
InterTrust Ref. No.: IT-7.1 (US)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Application of:

GINTER et al.

Group Art Unit: 2132

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Application No.: 09/398,665

Examiner: DARROW, Justin T.

Filed: September 17, 1999

For: DIGITAL CERTIFICATE SUPPORT
SYSTEM, METHODS AND
TECHNIQUES FOR SECURE
ELECTRONIC COMMERCE
TRANSACTION AND RIGHTS
MANAGEMENT (as amended)

OFFICIAL

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

FINAL UPDATED NOTICE REGARDING RELATED LITIGATION

Applicants submit this Final Updated Notice to inform the Examiner of the status of the litigation between InterTrust and Microsoft, captioned InterTrust Technology Corp. v. Microsoft Corp. (C 01-1640 SBA, N. D. Ca.). This paper is entitled "Final Notice" because this litigation has been dismissed with prejudice following settlement of the dispute.

Pursuant to 37 C.F.R. §§ 1.56 and 1.97(c), Applicants submit this paper to bring to the attention of the Examiner the information herein. This paper is being filed after the events recited in Section 1.97(b) but, to the undersigned's knowledge, before the mailing date of either a Final action, Quayle action, or a Notice of Allowance. Under the

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provisions of 37 C.F.R. § 1.97(c), this paper is hereby accompanied with instruction to charge a fee of \$180.00, as specified by Section 1.17(p), to our Deposit Account No. 06-0916.

Applicants hereby bring to the attention of the Examiner the following information and provide copies of the referenced documents for the Examiner's consideration. On February 23, 2004, Microsoft filed a Notice of Motion and Memorandum in Support of Motion for Partial Summary Judgment of Invalidity of the Asserted Claims of the '900 Patent (Anticipation). See Exhibit 1. On February 23, 2004, Microsoft also filed a Notice of Motion, Motion and Memorandum in Support of it's Motion for Partial Summary Judgment of Invalidity of the Asserted Claims of the '181 Patent (Anticipation). See Exhibit 2.

The parties subsequently settled and, on May 5, 2004, filed a Joint Stipulation of Dismissal with Prejudice. See Exhibit 3. Exhibit 4 is a copy of the press release announcing the settlement and indicating that Microsoft has taken a comprehensive license to InterTrust's patent portfolio for a one-time payment of \$440 million. See Exhibit 4.

Applicants note that they have not provided the Office with the exhibits referred to in Exhibits 1 and 2 because they are either (a) publicly available and not necessary to understand the motion, and/or (b) contain Microsoft's Attorneys-Eyes-Only information that we cannot disclose. If, however, the Examiner believes that any document not yet submitted may be helpful in resolving an issue before him and would like to review that

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or any other document, Applicants invite the Examiner to contact the undersigned at
(650) 849-6643.

Applicants submit this Final Updated Notice Regarding Related Litigation in fulfillment of their duty to disclose information potentially material to patentability under 37 CFR 1.56. This submission does not constitute an admission that any of the listed documents are material or constitute "prior art."

The instant application is also assigned to InterTrust and may bear relation to U.S. Patent Nos. 5,892,900 ("the '900 patent") and/or 6,112,181 ("the '181 patent"), referred to in Exhibits 1 and 2, by: 1) claiming the benefit of priority from ancestor Appln. No. 08/388,107 ("the '107 application") and/or the applications leading to the '900 and '181 patents; 2) incorporating by reference the '107 application or applications related thereto; and/or 3) containing statements that it is or may bear (subject matter) relation to the '107 application or applications related thereto.

If there are any fees due with the filing of this Notice which have not yet been paid, please charge the fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: August 3, 2004

By: 

Andrew B. Schwaab
Reg. No. 38,611

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